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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,805	02/21/2002	William E. Ortyn	BIOL0038	2051

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EXAMINER

YANG, NELSON C

ART UNIT PAPER NUMBER

1641

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/082,805	Applicant(s) ORTYN ET AL.	
	Examiner Nelson Yang	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34,35,37-40,42-44,46,49-51,54 and 56-61 is/are pending in the application.

4a) Of the above claim(s) 59 is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34, 35, 37-40, 42-44, 46, 49-51, 54, 56-58, 60-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 27, 2006 has been entered.

Response to Amendment

2. Applicant's amendment of claims 34, 35, 40, 42, 43, 46, 50, 51, 54 is acknowledged and has been entered.
3. Applicant's addition of claims 56-61 are acknowledged and have been entered.
4. Applicant's cancellation of claim 55 is acknowledged and has been entered.

Election/Restrictions

5. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 34, 35, 37-40, 42-44, 46, 49-51, 54, 56-58, 60-61, drawn to a method, classified in class 435, subclass 287.1.
 - II. Claim 59, drawn to an imaging system, classified in class 436, subclass 172.
6. The inventions are distinct, each from the other because of the following reasons:
7. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the

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product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the imaging system of group II can be used for pattern recognition or detection different color patterns in an image.

8. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

9. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

10. Newly submitted claim 59 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the imaging system of claim 59 can be used for pattern recognition or detection different color patterns in an image. Furthermore, a restriction requirement was made on October 6, 2004, in which applicant elected the method

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 59 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 34, 35, 37-40, 42-44, 46, 49-51, 54, 56-58, 60-61 are rejected under 35 U.S.C. 102(b) as being anticipated by Stern [US 5,981,956].

With respect to claims 34, 42, 54, 56, 60, 61, Stern teaches an array comprising regions (features - column 7, lines 10-15) containing different polymer sequences to be coupled in different known locations on the substrate surface (object) (column 5, lines 48-60). Target sequences labeled with detectable groups (probes) are contacted with the array (column 6, lines 52-60), where multiple probes may be used (column 8, lines 25-30). Dichroic beam splitters are used to separate signals from label groups having different response radiation wavelengths, thereby allowing simultaneous detection of multiple fluorescent indicators, and thus simultaneous interrogation of a single array with multiple target sequences (column 10, lines 15-35), where the response radiation from the targets are individually detected through additional detectors such as photomultiplier tubes (column 10, lines 33-50).

13. With respect to claims 35, 43, 57, target sequences labeled with a detectable group (probes) are contacted with the array (column 6, lines 52-60), which would be specific and bind to a complementary sequence.

14. With respect to claims 37, 39, 50, 51, photodetectors are used for the detection of relatively weak signals such as fluorescence (column 12, lines 35-40), which would come from the labels.

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15. With respect to claims 38, 44, the targets may include cells (column 4, lines 40-50).
16. With respect to claims 40, 46, 58, Stern teaches that multiple probes may be used (column 8, lines 25-30), where different labels bind to different locations, such that information based on the locations can be extracted (column 7, lines 35-45).
17. With respect to claims 49, the labels may be fluorescent (column 10, lines 28-31).

Response to Arguments

18. Applicant's arguments with respect to claims 34, 35, 37-40, 42-44, 46, 49-51, 54, 56-58, 60-61 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


19. No claims are allowed.
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nelson Yang whose telephone number is (571) 272-0826. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (571)272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nelson Yang
Patent Examiner
Art Unit 1641


LONG V. LE 03/06/07
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600